

### **REMARKS**

Claims 1-8, 10-18, 20-22, and 25-37 were pending. Claim 6 has been cancelled. Claims 1, 8, 12, 15, 21, 26, 29-31, 35, and 37 have been amended. Claim 44 has been added. Therefore, claims 1-5, 7-8, 10-18, 20-22, 25-37 and 44 remain pending subsequent entry of the present amendment.

#### **35 U.S.C. § 112 Rejections**

Claims 12 and 15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, it is suggested that the claims recite features which are not supported by the specification. Rather, it is suggested the specification only supports messages being stored at a remote server for access by many viewers. Applicant submits each of claims 12 and 15 are supported by the specification and are in compliance with 35 U.S.C. § 112. For example, the specification describes:

“In addition to the above, viewers may create messages and/or edit lists which may then be accessed by others. In one embodiment, viewers may store/post their created messages on a remote server which is accessible to many viewers. Alternatively, viewers may store their edit lists locally and make them available for access to many other viewers.” (Description, page 27, lines 3-5).

Accordingly, withdrawal of the rejections is requested.

#### **35 U.S.C. § 102 & § 103 Rejections**

In the present Office Action, claims 1, 3, 4, 6, 10, 13, 21, 26, 31, 33, 34 and 37 stand rejected as being anticipated by newly cited U.S. Patent Publication 2005/0267994 (hereinafter “Wong”). In addition, each of claims 1, 3, 17, 21, 31, 33 and 35 stand rejected under newly cited U.S. Patent No. 6,526,577 (hereinafter “Knudson”). Applicant has reviewed the newly cited references and submits each of the pending independent

claims recite features neither disclosed nor suggested by the cited art. Accordingly, Applicant traverses the above rejections and requests reconsideration in view of the following comments. Each of the remaining pending claims stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong and/or Knudson. However, as discussed below, each of the pending claims are patentable over Wong and/or Knudson, taken either singly or in combination with each other or the remaining cited art.

Claim 1 has been amended to generally incorporate features of prior claim 6. In the present Office Action, claim 6 was rejected as being anticipated by Wong. In particular, the following portions of Wong were cited as disclosing the features “wherein said tagging is performed on a television program previously stored on a mass storage device at the first location” as presently recited in claim 1.

“FIG. 3 illustrates a functional representation of the DVR 240 operating as part of the client system 40a in accordance with an aspect of the present invention. As mentioned above, the DVR 240 includes a mass storage device 242, such as a hard disk drive or other suitable non-volatile data storage device. The storage device 242 includes, among other things, a program list 280 that is indicative of audio and/or visual program content that is to be recorded.

The storage device also includes a program database 282 for storing recorded programs, such as in a compressed data format. As described herein, each program may be formed of a plurality of discrete program segments that are linked together and stored in the program database 282 so that the individual program segments may be combined in a predetermined order, such as may be indicated in the token(s) representing the program segments. The storage device 242 further may include a separate commercial database 284 for storing program segments corresponding to advertisements. It is to be appreciated that, for purposes of practicing the present invention, program segments for shows and advertisements may be employed in a substantially identical manner. As a result, program segments may be selectively combined at the client system in an order, such as may be indicated in a token representing a particular program or as may be programmed by a service provider. By way of example, the client system may be programmed to select commercials from its stored database based on viewing characteristics of the client system, such as, for example, who is watching, the time of day, the particular show being viewed, the

type of show, etc. In this way, program segments from the commercial database 284 may be dynamically inserted between adjacent pairs of program segments of a corresponding program from the program database 282 to provide customized advertisements during playback of the corresponding program.” (Wong, paras. 85-86).

As can be seen from the above, there is no disclosure of suggestion of the recited features regarding said tagging being performed on a television program previously stored on a mass storage device at the first location. The above disclosure is not related to tagging and merely provides a basic functional description of the DVR of Wong. Further, Wong is generally directed to techniques for an improved electronic program guide (EPG). To that end, Wong discloses a user may access a central server and search through available listings. A selected listing/program may have a token associated with it which provides related identifying information. However, the above recited features of claim 1 are wholly absent from Wong and claim 1 is patentably distinguished for at least this reason. Each of claims 21 and 31 recite similar features and are patentably distinguishable from Wong for similar reasons.

In addition to the above, claim 1 was rejected as being anticipated by Knudson. However, as no further rejection was made of prior claim 6 than that above in view of Wong, each of claims 1, 21 and 31 are likewise patentably distinguished from Knudson for at least the above reasons as well. Accordingly, each of claims 1, 21, and 31, as well as their dependent claims, are believed allowable.

Further, claim 35 stand rejected as being anticipated by Knudson. Claim 35 has been amended to recite that the central repository stores user created lists. These features are supported by at least pages 26-27 of the Description. In contrast, Knudson merely discloses the following:

“In response to a user selection of the “TV Clip” feature 1821 the program guide may, for example, provide the user with the opportunity to send a television programming video clip or still frame to someone else. The video clip may be stored in a video clip library (e.g., the screening room) that may be stored at main facility 12 or at a program

guide distribution facility 16. The video clip may be temporarily stored in digital form on a storage device or in memory, either of which may be part of the user's equipment (e.g., set-top box, personal computer, etc.).” (Knudson, col. 14, lines 58-66).

“The clip may be attached to a TV Mail message that may also be sent to the other person using, for example, a standard TV Mail (e.g., e-mail) address. Alternatively, the program guide may send a reference to the video clip, such as a clip identifier or the location of the clip. The receiving party may access the clip, for example, from the screening room when reading TV Mail. (Knudson, col. 15, lines 5-11).

As seen from the above, or from the remainder of Knudson, there is no disclosure of a central repository which stores user created lists as recited. In contrast, Knudson discloses users may access a program guide and video clips may be stored in a video clip library. Therefore, Knudson does not disclose all the features of claim 35 and claim 35 is patentably distinguished for at least the above reasons.

In addition to the above, present claim 12 (rewritten in independent form) recites the features wherein the message which is stored is stored at the first location, and wherein the stored message is retrieved by the second user from the first location. As discussed above, it was suggested that these features were not supported by the application. However, such support has been provided. In the present Office Action, these features of prior claim 12 were rejected in paragraph 12 as though the messages were stored at a remote server, rather than as recited in the claim. Having established support for these features, and that fact that none of the cited art discloses or suggests such features, claim 12 is believed allowable.

Still further, the dependent claims recite additional features neither disclosed nor suggested by the cited art. While not necessary in view of the above, an example is provided. Claim 15 recites “wherein the second user retrieves the message from the first location in a peer-to-peer mode.” It is suggested that the combination of Wong and McKissick (U.S. Patent Publication No. 2006/0190966) provide such features. In

particular, it is suggested that McKissick discloses messages are retrieved in a peer-to-peer mode as recited. The following from McKissick is cited in support:

"If desired, the television message system can deliver a message related to a given program to a particular message server with an indication that the message is intended for receipt by current viewers of the given program, users interested in the program, users interested in the channel of the program, or users interested in the category of the program. The message server may group the message with other messages relating to the given program, channel, or category. The message server then may allow any user's set-top box application to access all the messages for the programs, channels, or categories that the user at that set-top box is interested in or is currently viewing. Any other users who wish to access messages relating to a program, channel, or category of programs can download those messages from the message server onto their set-top boxes so that they can be read on a television set." (McKissick, para. 132).

However, the above clearly discloses a client-server architecture and nowhere teaches or suggests the peer-to-peer features as recited.

For at least the above reasons, the Applicant believes all claims to be patentably distinguishable from the cited. Accordingly, the application is believed to be in condition for allowance. However, should the examiner believe issues remain, the below signed representative requests a telephone interview at (512) 853-8866 to facilitate a resolution."

**CONCLUSION**

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5266-04400/RDR.

Respectfully submitted,

/ Rory D. Rankin /  
Rory D. Rankin  
Reg. No. 47884  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin,  
Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8800

Date: January 18, 2007